

REMARKS

Responsive to the Office Action mailed 27 June 2008, the present paper is timely filed on or before 27 September 2008. By the present paper, no claims are cancelled and no claims are amended.

The Office Action Summary recites that claims 1-8, 11, and 13 are rejected and that claim 12 is withdrawn. The Detailed Action recites that claims 1 – 11 and 13 are being examined. But by Reply and Amendment filed 12 February 2008, Applicant canceled claims 1, 12, and 13. The official status of claims 9 and 10 is ambiguous. Clarification is requested. Applicant responds according to his best understanding of the Office Action.

Because the Office Action leaves the official status of at least claims 9 and 10 unclear, Applicant respectfully submits that it would be improper to make the next action final.

Reconsideration of the Application in view of the following remarks is respectfully requested.

Applicant notes with gratitude that all rejections over the prior art were withdrawn.

At least claims 2 – 8 and 11 were rejected under 35 U.S.C. § 101 as allegedly being drawn to non-statutory subject matter. Because Applicant's claims define more than a disembodied concept and define a method that produces a tangible useful result, Applicant respectfully traverses.

The Office previously rejected claims 1 and 3 – 7 on the same grounds. In the prior rejection, the Office said: "This rejection could be overcome by amendment of the claims to recite that a result of the method is outputted to a display *or a memory* or another computer on a

network, or to a user, or by including a physical transformation.” Office Action of 12 September 2007, page 4, last paragraph bridging to page 5 (emphasis supplied).

In making and now maintaining the rejection, the Office apparently ignores step F) of, for example, claim 2. Step F) recites: “storing the information in a data file or in other form of digital memory.” In maintaining the rejection, the Office further overlooks the claim amendments made in Applicant’s Reply and Amendment of 12 September 2008. Those claim amendments were made in direct response to the Office’s statement quoted above, which statement the Office now appears to disavow. The cynical observer could view this as a case of the Office forcing Applicant to “hit a moving target”.

Applicant respectfully submits that step F) of claim 2, and the analogous steps in other claims, recite a useful result and that the claims therefore meet statutory requirements. The step of storing the information subsumes *per force* the act of “outputting” the information. The stored information can be perceived graphically, or as a table of alphanumeric characters. This is evidenced by the figures and tables of the present Application itself. This graphic and tabular physical output is just as useful to the man skilled in the relevant art as is, for example, the output from temperature or pressure detection and display devices. The chip, RAM module, or floppy disk on which the perceivable information is stored is no less a useful result than is a measurement process embodied in an electronic thermometer or pressure gauge having a readout.

The initial burden is on the Office to present a *prima facie* case that an invention fails to satisfy the practical application requirement and is hence non-statutory subject matter. *See, e.g.,* M.P.E.P. § 2106. When functional material is embodied in computer-readable material (i.e.

storage device), it is structurally and functionally integrated into the medium if the function of the functional material can be realized. The Office does not argue that Applicant's inventive method has no function. And the figures and tables of the present Application demonstrate that the function can be realized by the skilled artisan.

For the foregoing reasons, Applicant respectfully submits that the claim rejections under 35 U.S.C. § 101 are improper and should be withdrawn.

Based on the foregoing remarks, Applicant respectfully submits that the claims are now in condition for allowance, which allowance is earnestly solicited.

Applicant respectfully submits that no fee is due with this paper. If in fact a fee is due, the Commissioner is authorized to charge any fee(s) or fee(s) deficiency to Deposit Account No. 10-1250.

Respectfully submitted,
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